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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,498	04/16/2004	Xiugao Liao	STAAR-68373	1343
24201	7590	01/21/2005	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,498

Applicant(s)

LIAO, XIUGAO

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 18, 21 and 22 is/are rejected.  
7) ☒ Claim(s) 20 and 23-25 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### ***Specification***

The Specification is objected to because on pages 3 and 5, Applicant alludes to alkynyl groups that may be incorporated into the polymer product at terminal positions. However, all of the specific embodiments of the alkenyl group that follow are actually alkenyl, e.g. vinyl, allyl, allylbenzyl, etc. Each and every recitation of alkynyl in the disclosure should be replaced with the term "alkenyl".

### ***Claim Objections***

Claim 19 is, likewise, objected to because they recite the presence of alkynyl groups in some embodiments of their invention when it seems clear that it is actually alkenyl groups that are incorporated into the polymer.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 21 and 22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 18 and 22 of copending Application No. 10/308803. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Analysis***

It is noted that, in the most general description of Applicant's invention, the presence of other structural attributes aside from carbosilane and siloxane units are not expressly excluded in view of Applicant's use of the transitional phrase "having" after the word "copolymer" in claim 1. "Having" would seem to be synonymous with "comprising" which MPEP 2111.03 holds as being open-ended and, therefore, not limited only to the elements explicitly stated in the claim. Accordingly, for the purpose of evaluating the claimed invention against the prior art, it has been presumed that other structural moieties besides the carbosilane and carbosiloxane repeat units may be present.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Morita et al., JP 2000-131655. Morita discloses a formulation comprising a vinyl polymer bearing dendritic carbosiloxane substituents that, by virtue of its high oxygen permeability and scratch resistance, is useful as a ophthalmic lens material (abstract). The aforementioned polymer is prepared by polymerization of low-generation carbosiloxane dendrimers having polymerizable acrylic groups at their core. Specific examples of the acrylic group-functionalized carbosiloxane dendrimers are provided in formulae 23-36. In all instances, the dendrimer is a completely alternating copolymer of dimethyl siloxane and carbosilane repeat units wherein the carbon chain of the

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carbosilane repeat unit is 2 carbon atoms in length (although chains of up to 10 carbon atoms is contemplated in paragraph 14).

The copolymer disclosed by Morita is not crosslinkable by a hydrosilylation mechanism (or, for that matter, any other mechanism) hence the limitations of claim 20 is not satisfied. The adjuvants recited in claims 23, and 24 are not mentioned by the reference. Finally, the reference's anticipation of claim 1 notwithstanding, it would not be appropriate to state that the copolymer disclosed therein inherently possesses the refractive index reported in claim 25 because of its departure from the preferred structure of the claimed copolymer.

Tapsak, U.S. patent no. 6,534,587, is cited as being of interest because it discloses similar copolymers and their utilization for the preparation of various biomedical products. However, ophthalmic lenses are not expressly mentioned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 9, 2004

*Mark Zimmer*  
*AU 1712*